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P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER	
SANDERS, STEPHEN	

ART UNIT	PAPER NUMBER
2434	

MAIL DATE	DELIVERY MODE
06/18/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/525,138	HE ET AL.	
	Examiner	Art Unit	
	STEPHEN SANDERS	2434	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 April 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-6,8-15,18 and 20-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-6,8-15,18 and 20-25* is/are rejected.

7)☒ Claim(s) *14, 15, and 24* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action has been issued in response to Amendments to the claims, and Remarks filed on April 12, 2010. Claims 1, 2, 4-6, 8-15, 18, and 20-25 are currently pending, in which claims 1, 5-6, and 8-9 are in independent form.

Status of Claims:

Claims 1, 2, 4-6, 8-15, 18, and 20-25 are rejected under 35 U.S.C. 103(a).

Claim 6 is rejected under 35 USC § 112, 2nd Paragraph.

Claims 14, 15, and 24 are dependent on 35 USC § 112, 2nd Paragraph rejected claim 6, and are objected to.

Accordingly, this action has been made FINAL.

Response to Amendment

Applicant's amendments to the Claims have been received and entered, in which claim 25 has been added. The invoking of the 35 U.S.C. § 112, 6th paragraph necessitates the 112, 2nd paragraph rejections for claims 6, 14, 15, and 24 and are shown below (see Claim Rejections - 35 USC § 112 below). Applicant's Argument filed April 12, 2010 is responded to below.

Response to Arguments

Applicant argues that "authenticating the memory medium by comparing said memory medium properties with corresponding properties or a corresponding memory medium legally produced by a provider, before sending the additional data to the device" is not disclosed by the prior art. Examiner respectfully disagrees. Schwartz

discloses (Abstract) "a method for authenticating that a specified prerecorded media, such as a CD, is in the possession of a user..." and "If the prerecorded media has the predetermined information, then the user of the electronic device is allowed to download additional data via the network". The Applicant also discusses a "region code" as part of the memory medium properties. Examiner points out that the "region code" is discussed and referenced by Collart teachings and are also shown in previous Office Action.

The invoking of 112, 6th paragraph necessitates the further examination of Applicant's specification and related drawings, etc. to determine whether there exists corresponding adequate support for the claimed "means." The associated 35 USC § 112 rejections are shown below in the Claim Rejections - 35 USC § 112, and the invoking of 35 USC § 112, 6th Paragraph is also shown below. Note: The claim language may be changed accordingly so that the claims do not invoke the 35 USC § 112, 6th Paragraph. As such, Applicant's arguments have been fully considered and are not persuasive. Applicant's claim amendments have been entered. Accordingly, as stated above, the rejections remain and are shown below with respect to the amended claims including newly added claim 25.

Claim Rejections - 35 USC § 112

1. Claim 6 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

35 USC § 112, 6th Paragraph

2. The following is a quotation of 35 U.S.C. 112, 6th Paragraph:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

3. The language of multiple elements within independent claim 6 recited the means-plus-function language and invoked 35 U.S.C. 112, sixth paragraph. These claim elements of independent claim 6 contain the "means for" phrase, and are modified by the following functional language respectively: "retrieving memory medium properties ..."; "authenticating said memory medium ..."; and "determining that the memory medium ...". Additionally, they are not modified by sufficient structure and thereby are being treated under 35 U.S.C. 112, sixth paragraph.

4. No other claims and/or claim elements invoke 35 U.S.C. 112, sixth paragraph.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-2, 4-6, 8-15, and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al, (U. S. Patent Number WO 01/90860 A2), hereinafter Schwartz, in view of Collart (U.S. Patent Number 6,405,203).

As to claim 1, the following is taught: "A communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of:

extracting memory medium properties from the memory medium inserted in the device, sending said memory medium properties to the remote unit, authenticating the memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to the device, and determining that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium" (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; page 4, lines 4-8; page 5, lines 20-22; page 14; See claims starting page 16; also see Response to Arguments);

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 1, but fails to teach: region codes and their usage. However, Collart teaches "wherein the memory medium properties include a region code of the memory medium" (region code, storage; Collart: Abstract; column 19, lines 21-25; column 25, lines 58-62).

In view of Collart's teachings regarding region codes and their usage, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include region codes and their usage in determining the memory medium's authenticity. Although these specifics are not recited by Schwartz, one would be motivated to use any and all region code usage techniques in order to provide for proper and legal data reproducing, and prevent illegal copying of recorded data.

As to claim 2, the following is taught: "The communication method as claimed in claim 1, wherein the memory medium properties are written in a control data zone of the memory medium." (Schwartz teaches: Abstract, Detailed Description of the Preferred Embodiment: page 4, lines 4-8; page 5, lines 6-11; See claims starting page 16).

As to claim 4, the following is taught: "The communication method as claimed in claim 1, wherein the remote unit is able to send different types of additional data as a function of the memory medium properties." (Schwartz teaches: Detailed Description of the Preferred Embodiment: page 13, line 27 to page 14, line 2; See claims starting page 16).

As to claim 5, the following is taught: "A communication system comprising a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said device and the remote unit communicating via a network, wherein the remote unit is able to retrieve memory medium properties from the memory medium inserted in the device, to authenticate said memory medium by comparing said

memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to said device and to determine that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium." (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; page 4, lines 4-8; page 5, lines 20-22; page 14; See claims starting page 16; also see Response to Arguments);

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 5, but fails to teach: region codes and their usage. However, Collart teaches "wherein the memory medium properties include a region code of the memory medium" (region code, storage; Collart: Abstract; column 19, lines 21-25; column 25, lines 58-62).

In view of Collart's teachings regarding region codes and their usage, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include region codes and their usage in determining the memory medium's authenticity. Although these specifics are not recited by Schwartz, one would be motivated to use any and all region code usage techniques in order to provide for proper and legal data reproducing, and prevent illegal copying of recorded data.

As to claim 6, the following is taught: "A remote unit for communicating with a device able to read a memory medium, the remote unit comprising additional data for

the memory medium, means for retrieving memory medium properties from the memory medium inserted in the device, means for authenticating said memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to said device and means for determining that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory includes identical content for rendering as the corresponding memory medium" (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 5, lines 6-11; page 5, lines 20-22; page 14; See claims starting page 16; also see Response to Arguments).

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 6, but fails to teach: region codes and their usage. However, Collart teaches "wherein the memory medium properties include a region code of the memory medium" (region code, storage; Collart: Abstract; column 19, lines 21-25; column 25, lines 58-62).

In view of Collart's teachings regarding region codes and their usage, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include region codes and their usage in determining the memory medium's authenticity. Although these specifics are not recited by Schwartz, one would be motivated to use any and all region code usage techniques in order to provide for proper and legal data reproducing, and prevent illegal copying of recorded data.

As to claim 8, the following is taught: "A computer readable medium embodying a computer program comprising program instructions for implementing, when said program is executed by a processor, a communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of: extracting memory medium properties from the memory medium inserted in the device, sending said memory medium properties to the remote unit, and determining that the memory medium is illegally produced when the memory medium properties are different from corresponding properties of a corresponding memory medium legally produced by a provider even if the memory medium includes identical content for rendering as the corresponding memory medium." (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 3, lines 1-10; page 5, lines 9-11; page 5 line 26 to page 12, line 26; page 14; See claims starting page 16; also see Response to Arguments).

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 8, but fails to teach: region codes and their usage. However, Collart teaches "wherein the memory medium properties include a region code of the memory medium" (region code, storage; Collart: Abstract; column 19, lines 21-25; column 25, lines 58-62).

In view of Collart's teachings regarding region codes and their usage, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was

made to specifically include region codes and their usage in determining the memory medium's authenticity. Although these specifics are not recited by Schwartz, one would be motivated to use any and all region code usage techniques in order to provide for proper and legal data reproducing, and prevent illegal copying of recorded data.

As to claim 9, the following is taught: "A computer readable medium embodying a computer program comprising program instructions for implementing, when said program is executed by a processor, a communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of: retrieving memory medium properties from the memory medium inserted in the device, authenticating the memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to the device, and determining that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium." (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 5, lines 6-11; page 5, lines 20-22; page 5, line 26 to page 12, line 26; page 14; See claims starting page 16; also see Response to Arguments).

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 9, but fails to teach: region codes and their usage. However, Collart teaches "wherein the memory medium properties include a region code of the memory medium" (region code, storage; Collart: Abstract; column 19, lines 21-25; column 25, lines 58-62).

In view of Collart's teachings regarding region codes and their usage, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include region codes and their usage in determining the memory medium's authenticity. Although these specifics are not recited by Schwartz, one would be motivated to use any and all region code usage techniques in order to provide for proper and legal data reproducing, and prevent illegal copying of recorded data.

As to claim 10, the following is taught: "The communication method of claim 1, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 11, the following is taught: "The communication method of claim 1, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 12, the following is taught: "The communication system of claim 5, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 13, the following is taught: "The communication system of claim 5, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 14, the following is taught: "The remote unit of claim 6, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 15, the following is taught: "The remote unit of claim 6, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 20, the following is taught: "The communication method of claim 1, wherein the additional data includes advertisement depending on the region code"

(advertising; Collart: Abstract; Figures 8, 9; column 4, lines 35-38; column 16, lines 54-57; column 20, line 26; column 21, line 16).

As to claim 21, the following is taught: "The communication method of claim 1, further comprising the act of allowing recording of the additional data if the authenticating act is successful" (Schwartz: Abstract; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21).

As to claim 22, the following is taught: "The communication method of claim 1, further comprising the act of allowing access to the additional data only while the memory medium is being played in the device" (Schwartz: Abstract; page 1, line 19 to page 2, line 17; page 5, lines 20-27; page 12, line 16).

As to claim 23, the following is taught: "The communication system of claim 5, wherein the additional data includes advertisement depending on the region code" (advertising; Collart: Abstract; Figures 8, 9; column 4, lines 35-38; column 16, lines 54-57; column 20, line 26; column 21, line 16).

As to claim 24, the following is taught: "The remote unit of claim 6, wherein the additional data includes advertisement depending on the region code" (advertising; Collart: Abstract; Figures 8, 9; column 4, lines 35-38; column 16, lines 54-57; column 20, line 26; column 21, line 16).

As to claim 25, the following is taught: "The communication system of claim 5, wherein the region code is stored in a secondly content provide, information of a control data zone of a lead-in area of the memory medium; the control data zone further including physical format information; the physical format information including book type, disc size, disc structure, and burst cutting area (BCA) descriptor (genre/type BCA information; Collart: column 21, lines 52-58); wherein the disc structure includes a number of layers of the disc, a layer type and a track path (structural arrangement; (Schwartz: page 2, lines 12-17), and the secondly content provider information further include copyright (copyright protection; Collart: column 32, lines 41-48) information.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al, (U. S. Patent Number WO 01/90860 A2), hereinafter Schwartz, in view of Collart (U.S. Patent Number 6,405,203), in further view of Valente et al (U.S. Publication Number 2003/0110192 A1), hereinafter Valente.

As to claim 18, the following is taught: "The communication method of claim 1 (See claim 1 above).

As to the above parenthesized references, Schwartz, and Collart teach the referenced elements of claim 18, but fails to teach: "blacklisting the device if the remote unit receives a number of requests higher than a predetermined threshold from the device containing a non-authenticated memory medium". However, Valente teaches blacklisting a device after it exceeds a number of attempts of "illegal" operations and renders device incapable of conducting further activities (Valente: page 6, paragraph [0070]). In view of Valente's teachings regarding blacklisting techniques, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include blacklisting techniques in determining device authentication. Although these specifics are not recited by Schwartz, and Collart, one would be motivated to use any and all blacklisting techniques in order to provide for better and faster authentication management, and prevent illegal copying of recorded data.

Conclusion

9. **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEPHEN SANDERS whose telephone number is (571)270-5308. The examiner can normally be reached on M - F; 7:30a.m. - 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on 571-272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen Sanders/
Examiner, Art Unit 2434
/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434